88-1494

No. _____

Supreme Court, U.S.
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In The

# Supreme Court of the United States

October Term, 1988

MICHAEL J. BADALAMENTI,

*Petitioner,*

vs

DUNHAM'S INC., KINNEY SHOE CORPORATION and HYDE ATHLETIC INDUSTRIES, INC.,

*Respondents.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

*– AND APPENDICES –*

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## QUESTION PRESENTED

### SEVENTH AMENDMENT RIGHT TO TRIAL BY JURY

Where defendants had the burden of proving patent invalidity by clear and convincing evidence, did the court violate Badalamenti's Seventh Amendment rights by taking a material factual issue away from the jury in directing a verdict of invalidity at the close of Badalamenti's case in chief?

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DUNHAM'S INC., KINNEY SHOE CORPORATION and HYDE ATHLETIC INDUSTRIES, INC.,

*Respondents.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner Michael J. Badalamenti respectfully prays that a Writ of Certiorari issue to review the Judgment and Opinion of the United States Court of Appeals for the Federal Circuit entered October 28, 1988.

### OPINIONS BELOW

The unreported Opinion of the United States Court of Appeals for the Federal Circuit is reproduced in the Appendix. (A-1 – A-3.) The Opinion of the United States District Court for the Eastern District of Michigan on Hyde's Motion For A Directed Verdict is reported at 6 U.S.P.Q.2d 1626, and is reproduced in the Appendix. (B-1 – B-21.)

### JURISDICTION

The Judgment of the Federal Circuit was entered on October 28, 1988. (C-1.) A timely Petition For Rehearing was denied on December 9, 1988, and this Petition For

Certiorari was filed within 90 days of that date. The Federal Circuit Order denying rehearing is reproduced in the Appendix. (D-1.) This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

## SEVENTH AMENDMENT OF THE U.S. CONSTITUTION

The Seventh Amendment to the U.S. Constitution provides:

> In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any court of the United States, than according to the rules of the common law.

## STATEMENT OF THE CASE

Badalamenti sued Hyde for infringement of U.S. Patent No. 4,335,529 in the United States District Court for the Eastern District of Michigan. The '529 patent issued for a running shoe. The novel feature of the running shoe was a set of cleats extending at an acute angle from the side of the shoe on the forward portion of the shoe so that upon minor foot rotation (such as on a lateral cut) the cleats would engage the ground and prevent slipping.[1] Badalamenti tried his

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[1] Claims 1 and 6 are the pertinent claims in this suit, since the defendants were accused of infringing claim 6, which is dependent upon independent claim 1.

Claim 1 provides:

> 1. A running shoe comprising an outer side, an inner side, a sole, a first traction surface, and a second traction surface, wherein:

(*Concluded on page 3*)

case in chief to a jury from January 12-20, 1988. After Badalamenti rested, the court directed a verdict of invalidity in Hyde's favor, which was entered on February 19, 1988.

## A.

## HYDE'S INVALIDITY DEFENSE

One of Hyde's defenses was that Badalamenti failed to satisfy the requisites of 35 U.S.C. § 103, reproduced immediately below:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . .

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(*Continued from page 2*)

> said first traction surface and said second traction surface are associated with and disposed on the inner side and the outer side, respectively, of the upper portion of said shoe; each of said traction surfaces extends along a side of said shoe from about the forward portion of the heel to about the region where the toe area commences; and each of said traction surfaces is disposed above said sole of the shoe at an acute angle; whereby, when said shoe is rotated about a horizontal axis, at least one of said traction surfaces is brought into contact with the ground surface.

Claim 6 provides:

> 2. The shoe of claim 1 wherein the traction surfaces comprise a plurality of nubs protruding from the traction surface.

## B.

## DEFENDANTS HAVE THE BURDEN OF PROVING INVALIDITY BY CLEAR AND CONVINCING EVIDENCE

35 U.S.C. § 282 provides in part:

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

This burden is one of clear and convincing evidence. *Connell* v. *Sears, Roebuck & Co., Inc.*, 722 F.2d 1542, 1550 (Fed. Cir. 1983).

As a patent is presumed valid and a defendant has the burden of establishing invalidity by clear and convincing evidence, patentees have been exhorted to order the presentation of their proofs in reliance upon the presumption they enjoy. The Honorable Howard T. Markey, Chief Judge, U.S. Court of Appeals for the Federal Circuit, states:

> [T]he patentee's countering evidence has a place in an orderly trial, and that place is after defendant's invalidity evidence in chief. Invalidity, it must be remembered, is a *defense*. Trial time should not be wasted while a patentee attempts to disprove a defense that has not been presented, a defense that may well be stronger in the patentee's mind than the actual presentation

that might have been made by a defendant required to shoulder its statutory burden.

Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369, 374 (1986). [Emphasis in original.]

## C.

## THE SCOPE AND CONTENT OF THE PRIOR ART ARE QUESTIONS OF FACT

This Court has enunciated the test for obviousness under § 103 in *Graham* v. *John Deere of Kansas City:*

> While the ultimate question of patent validity is one of law, the Subsection 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under Subsection 103, the scope and content of the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.
>
> 383 U.S. 1, 17 (1966).

## D.

## THE TRIAL RECORD ON THE OBVIOUSNESS ISSUE

In presenting his case in chief, Badalamenti produced several witnesses who testified on the scope and content of the prior art. The scope and content of the prior art is relevant to the issue of infringement. *Graham* v. *John Deere of Kansas City*, 383 U.S. at 33.

Badalamenti's expert, Altaf Ali, testified that the Bowerman patent did not disclose a solution to the

problem of sideways slipping.[2] (E-1 – E-2.) Ali also testified that Badalamenti's invention was not obvious. (E-5 – E-7.) This was the only testimony given on the ultimate issue of obviousness.

At the close of Badalamenti's case in chief, Hyde moved for a directed verdict of invalidity under Fed. R. Civ. P. 50.

The District Court judge granted Hyde's motion, sent the jury home, and dismissed the case.

## E.

## THE DISTRICT COURT'S OPINION

In directing this verdict, the District Court rewrote the Bowerman patent drawing and made credibility determinations that were clearly the province of the jury. After stating "The single most relevant prior art is the Bowerman patent," the court redrafted the drawing in the Bowerman patent in a light most favorable to Hyde. (B-14.) Despite a clear absence in the drawing of acutely angled cleats[3], the District Court found that "the drawing appears to be in error." (B-16.)

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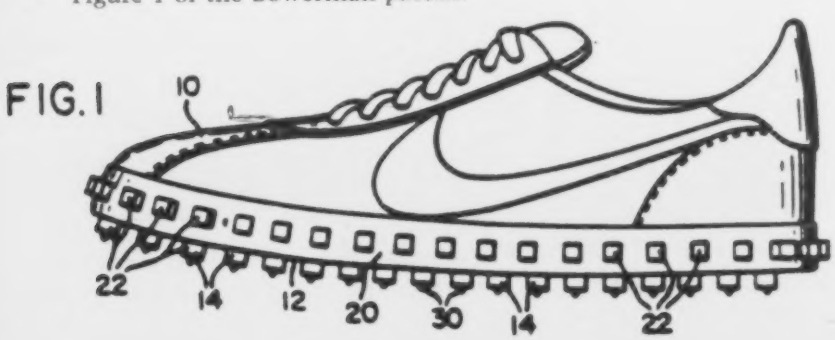
[2] Badalamenti also presented testimony that two Nike shoes, the "Astrograbber" and the "Waffle Racer" were different in design from Badalamenti's invention, and failed to solve the slipping problem solved by Badalamenti's invention. (E-2 – E-5; E-7 – E-10.)

[3] Figure 1 of the Bowerman patent:



The court stated:

> A fair reading of the claims and specification of Bowerman shows that it teaches an angled traction surface, and that the drawings showing a traction surface at a right angle to the sole or ground surface is in error.
>
> (B-15.)

The court raised and resolved this critical factual issue despite the substantial testimony to the contrary, despite no evidence to support this finding, and despite the absence of any showing in Bowerman of acutely angled cleats.

### E.

### THE FEDERAL CIRCUIT AFFIRMANCE

The Federal Circuit affirmed the District Court's verdict without addressing the District Court's redrafting of the Bowerman drawing. (A-1 – A-3.)

## ARGUMENT

The drawings of the Bowerman patent are clear. They teach cleats extending at a right angle to the side of a shoe. In violation of the Seventh Amendment, the District Court made a material fact finding contrary to the evidence of record in order to direct a verdict against Badalamenti. The court found the drawings "in error," and in making this finding, disregarded not only the plain disclosure of Bowerman, but testimony that Bowerman failed to solve the sideways slipping problem solved by Badalamenti.

In making this impermissible fact finding, the lower court ignored the guidelines established by this Court

in *Brady* v. *Southern Railway Co.*, 320 U.S. 476 (1943), and *Brady*'s progeny. As this Court stated:

> Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict. The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.
>
> *Anderson* v. *Liberty Lobby Co., Inc.*, — U.S. —, —, 106 S.Ct. 2505, 2510 (1986), citing *Adickes* v. *S. H. Kress and Co.*, 398 U.S. 144 (1970).

Indeed, the trial court substituted its choice for that of the jury. As this Court has stated in *Atlantic & Gulf Stevedores, Inc.* v. *Ellerman Lines, Ltd.*, 369 U.S. 355, 358-9 (1962):

> We might agree with the Court of Appeals had the questions of fact been left to us. But neither we nor the Court of Appeals can redetermine facts found by the jury any more than the District Court can predetermine them. For the Seventh Amendment says that "no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law."

In short, the trial court invaded the province of the jury. There was no evidence that the Bowerman drawing was wrong. Yet, even if there was a question as to whether the drawing was in error — it was a question of fact for the jury — not the court.

Under the procedure followed by the trial court, if a patentee introduces evidence in his case in chief on

infringement which also raises a factual issue on validity, he risks loss of the presumption — as well as his patent — if he does not put in his case on validity. This sets a dangerous precedent for the plaintiff patentee which would require him to put in validity proofs even though he doesn't know what proofs defendants will offer in their case in chief to meet their burden of establishing invalidity by clear and convincing evidence.

If the presumption has any force, a patentee should not have to prove his patent valid in his case in chief. It was improper for the court to direct a verdict on an issue for which Badalamenti did not have the burden in his case in chief. The procedure followed by the court below is in direct conflict with the admonition of Chief Judge Markey and flatly contrary to the presumption of validity and burden of proof allocation of 35 U.S.C. § 282.

The violation of Badalamenti's Seventh Amendment rights is compounded by the trial court's disregard of the statutory presumption of validity.

## CONCLUSION

Exercise of this Court's power of supervision is required to conform Federal Circuit directed verdict practice with long-settled precedent, and the Seventh Amendment.

Accordingly, the Writ of Certiorari should issue to review the Judgment and Opinion of the Federal Circuit in this case.

Respectfully submitted,

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Dated: March 8, 1989

# APPENDICES TO PETITION FOR CERTIORARI

• • •

## APPENDIX A

### DECISION

*– NOTE –*

*This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.*

*The decision will appear in tables published periodically.*

(United States Court of Appeals — Federal Circuit)

(Decided October 28, 1988)

(MICHAEL J. BADALAMENTI, Plaintiff-Appellant, v. DUNHAM's, INC., KINNEY SHOE CORP. and HYDE ATHLETIC INDUSTRIES, INC., Defendants-Appellees — No. 88-1356)

Before: BISSELL, *Circuit Judge*, BENNETT, *Senior Circuit Judge*, and ARCHER, *Circuit Judge*.

ARCHER, *Circuit Judge*.

Michael J. Badalamenti (Badalamenti) appeals the judgment of the United States District Court for the Eastern District of Michigan, 680 F. Supp. 256, 6 USPQ2d 1626 (1988), holding that U.S. Patent No. 4,335,529 ('529) is invalid under 35 U.S.C. § 103 (1982 & Supp. IV 1986). Badalamenti also appeals from the district court's Memorandum Opinion Taking Under Advisement Defendants' Petition for an Award of Attorney Fees and Costs. We *affirm* the judgment and *dismiss* the appeal from the Memorandum Opinion for lack of jurisdiction.

*OPINION*

The district court directed a verdict after the close of Badalamenti's case-in-chief that the '529 patent would have been obvious under 35 U.S.C. § 103. Badalamenti argues that a patentee has a statutory presumption of validity and that it was therefore improper to direct a verdict without hearing the defendants' evidence on the invalidity issue and Badalamenti's rebuttal evidence. This argument is unpersuasive because during Badalamenti's case-in-chief on infringement he offered into evidence the prior art (the Bowerman patent or the Nike shoes, and the Lotus, Cisko, and Lyne patents). The district court relied upon this evidence in its obviousness determination and found that it was enough to overcome the presumption of validity and to hold the '529 patent invalid for obviousness. Under these circumstances it was not improper for the district court to direct the verdict without further evidence.[1]

Badalamenti further argues that the district court erred in holding that the claimed invention of the '529 patent would have been obvious. However, we conclude the district court correctly analyzed the prior art and properly held the '529 patent invalid. Therefore we affirm the district court's opinion in this regard.

Badalamenti also appeals the determination by the district court in its Memorandum Opinion "that costs and attorney fee sanctions against plaintiff and plaintiff's counsel, pursuant to Rule 37(d), should be imposed." 6 USPQ2d 1633, 1635, 118 F.R.D. 337, 440 (1987). However, the district court held that "Defendants' effort to secure

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[1] Badalamenti's argument that this evidence was only introduced for the purposes of claim construction is flawed. Even though the evidence is introduced for the purposes of claim construction in determining infringement, if it is prior art the district court may consider it for invalidity purposes.

all costs and attorney fees incurred following plaintiff's failure to disclose the Nike talks is premature. . . . Accordingly, Defendants' Petition for an Award of Attorney Fees and Costs is TAKEN UNDER ADVISEMENT until after the jury verdict in this cause." A final judgment with respect to attorney fees has not been rendered. Accordingly, this court does not have jurisdiction to hear this portion of the appeal, *see* 28 U.S.C. § 1295(a) (1982 & Supp. IV 1986), and it is dismissed.

## APPENDIX B

### MEMORANDUM OPINION AND ORDER

(United States District Court —
Eastern District of Michigan — Southern Division)

(Filed February 19, 1988)

(MICHAEL J. BADALAMENTI, Plaintiff, v. DUNHAM'S, INC., KINNEY SHOE CORPORATION, and HYDE ATHLETIC INDUSTRIES, INC., Defendants — Civil Action No. 85-71040; Hon. John Feikens)

*I.*

INTRODUCTION

Plaintiff Michael Badalamenti obtained a patent for "a traction device for shoes." U.S. Patent No. 4,335,529, issued June 22, 1982 (plaintiff's patent). After obtaining the patent he contacted athletic shoe manufacturers to interest them in making his shoe. None were. Plaintiff also confronted various manufacturers who were, in his opinion, infringing his patent. He granted licenses to three manufacturers, but is not currently receiving royalty payments from any of the three.

Plaintiff filed his complaint on March 7, 1985, against Hyde Athletic Industries, Inc., a Massachusetts shoe manufacturer, and Dunham's Inc. and Kinney Shoe Corp., two local shoe retailers who sold Hyde's shoe. Hyde defended on behalf of the other two defendants. Plaintiff's complaint alleges that the defendant Hyde's "Monster" athletic shoe infringes his patent. 35 U.S.C. § 271.

I have jurisdiction pursuant to 28 U.S.C. § 1338(a).

Defendants moved for summary judgment in August 1985. I granted their motion, entering my memorandum opinion and order February 4, 1986. I concluded that defendant Hyde's shoe did not literally infringe plaintiff's patent and that the doctrine of file wrapper estoppel prevented a finding of infringement under the doctrine of equivalents. Plaintiff appealed March 13, 1986. The U.S. Court of Appeals for the Federal Circuit vacated my order for summary judgment. *Badalamenti v. Dunham's Inc., et al.*, Nos. 86-1024 and 86-1064, slip op. (Fed. Cir. Dec. 18, 1986). While upholding my determination of no literal infringement, the U.S. Court of Appeals stated that the plaintiff might be entitled, under the doctrine of equivalents, to recapture certain patent claims I found he had given up in prosecution. Slip op. at 6. The U.S. Court of Appeals remanded the case to this court for further fact finding to determine the scope of plaintiff's claims.

In conducting discovery after remand, having previously sought production of evidence of any prior negotiations of plaintiff with others and receiving no adequate response thereto, defendant Hyde independently determined that plaintiff and his attorneys had negotiated with Nike, an athletic shoe manufacturer, some two years earlier regarding possible infringement by Nike and licensing of plaintiff's invention. The Nike negotiations concerned pertinent prior art, in the form of two shoes manufactured by Nike, the "Astrograbber" and the "Waffle Racer".

Defendants filed a motion for dismissal with prejudice and for attorney fees and costs under Fed. R. Civ. P. 37, claiming that the plaintiff should have produced this information in response to the request for production of documents filed two years earlier. After an evidentiary hearing I granted defendants' motion as to

sanctions and denied it as to dismissal with prejudice. I have the determination of the sanctions amount under consideration.

Partially because of the newly discovered evidence, I am now presented with the issue of whether plaintiff's patent is invalid because it is obvious.

The case has been tried to a jury in accordance with plaintiff's request.

At the close of plaintiff's presentation of evidence to the jury, defendant Hyde moved for a directed verdict upon the ground that plaintiff's patent is obvious, and thus invalid under 35 U.S.C. § 103. Defendant bases his motion upon the evidence of the prior art introduced by plaintiff.

The prior art which plaintiff introduced is (1) United States Patent No. 4,194,310, issued March 25, 1980 to Bowerman (Bowerman patent); (2) Nike Astrograbber athletic shoe; (3) Nike Waffle Racer shoe; (4) United States Patent No. 2,878,592, issued March 24, 1959 to Cisko, Jr. (Cisko patent); (5) United States Patent No. 2,179,942, issued November 14, 1939, to Lyne (Lyne patent); and (5) United Kingdom Patent No. 407,499, issued March 22, 1934, to Lotus, Ltd. (Lotus patent).

Plaintiff also had two expert witnesses testify, Alsaf Ali and Thomas Montgomery.

It became obvious to me during the trial that plaintiff introduced the evidence of prior art partly upon a mistaken assumption. His position was that the question of obviousness invariably presents a fact question for the jury, and cannot be decided by directed verdict. This is incorrect as a matter of law, as the U.S. Court of Appeals for the Federal Circuit has stated.

*II.*

DIRECTED VERDICT

Plaintiff contends that the issue of obviousness is one for the jury, and not one for the court. It is well settled, however, that although the issue of obviousness often rests upon factual determinations, it does not invariably raise a question for the jury.

A. *The Issue Of Obviousness Is A Question Of Law*

The issue of obviousness, although based on factual inquiries, is a question of law which is to be decided by the trial court. *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 280, 189 U.S.P.Q. 449, 452 (1976); *Graham* v. *John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966); *Panduit Corp.* v. *Dennison Mfg. Co.*, 810 F.2d 1561, 1566-68, 1 U.S.P.Q.2d 1593, 1595-97 (Fed. Cir. 1987), *cert. denied*, __ U.S. __, 107 S.Ct. 2187. While the *Graham* analysis of obviousness is generally considered factual, the U.S. Court of Appeals for the Federal Circuit has stated that the inquiry is "factual" only to the extent that there are disputed facts. If none exist, the entire question of obviousness is one for the court. *Structural Rubber Products Co.* v. *Park Rubber Co.*, 749 F.2d 707, 721, 223 U.S.P.Q. 1264, 1274-75 (Fed. Cir. 1984).

Plaintiff is thus not automatically entitled to have the factual inquiries underlying obviousness decided by the jury. That the parties dispute the ultimate conclusion of obviousness is not sufficient to raise a fact question. *Id.* As the U.S. Court of Appeals for the Federal Circuit has stated:

> [B]efore submitting the issue of obviousness to the jury, the court must consider whether there is an underlying factual dispute on this issue. If there is none, the issue should not be given to

> the jury since the application of the law to undisputed facts is for the court.
>
> *Structural Rubber Products*, 749 F.2d at 721, 223 U.S.P.Q. at 1275.

Even if there are disputed facts, "a verdict should still be directed if the *undisputed facts* demonstrate, as a matter of law, that the patent in suit is invalid." *Brunswick Corp.* v. *Champion Spark Plug Co.*, 689 F.2d 740, 752, 216 U.S.P.Q. 1, 10 (7th Cir. 1982) (emphasis in original).

I find that there are no factual disputes concerning the scope and content of the prior art, the level of ordinary skill in the art, and the secondary considerations. What disputes exist result from claim interpretation, which is a matter of law for the court. *Panduit*, 810 F.2d at 1567-68, 1 U.S.P.Q.2d at 1597.

B. *Legal Standards For Reaching A Directed Verdict*

The U.S. Court of Appeals for the Federal Circuit has discussed the legal standard for deciding motions for directed verdicts and judgments notwithstanding the verdict on the issue of patent validity. *Quaker City Gear Works, Inc.* v. *Skil Corp.*, 747 F.2d 1446, 1454-55, 223 U.S.P.Q. 1161, 1166-67 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1136, *quoting Connell* v. *Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983). In *Connell* the U.S. Court of Appeals for the Federal Circuit stated the applicable legal standard as follows:

> Under these guidelines, a court must: (1) consider all the evidence; (2) in a light most favorable to the non-mover; (3) drawing reasonable inferences favorable to the non-mover; (4) without determining credibility of witnesses; and (5) without substituting its choice for that of the jury between conflicting elements in the evidence. . . . If, after following those guidelines, the court is convinced upon the record before

> the jury that reasonable persons could not reach or could not have reached a verdict for the non-mover, it should grant the motion for directed verdict or for JNOV.

722 F.2d at 1546, 220 U.S.P.Q. at 197.

In addition, the patent holder enjoys a statutory presumption that the patent is valid. 35 U.S.C. § 282. The party challenging the validity of the patent can overcome this presumption only by clear and convincing evidence to the contrary. *Panduit*, 810 F.2d at 1569-70, 1 U.S.P.Q.2d at 1598-99 and *Stratoflex, Inc.* v. *Aeroquip Corp.*, 713 F.2d 1530, 1534, 218 U.S.P.Q. 871, 875 (Fed. Cir. 1983). When the party challenging the patent has met the burden of overcoming this presumption of validity with clear and convincing evidence, the court should declare the patent invalid. *Panduit*, 810 F.2d at 1570, 1 U.S.P.Q.2d at 1599. Thus, I start with the presumption that Badalamenti's patent is nonobvious.

The court must also give deference to the Patent and Trademark Office's (PTO) decision to issue a patent with respect to evidence that it considered. *Structural Rubber Products*, 749 F.2d at 714, 223 U.S.P.Q. at 1269, *quoting American Hoist & Derrick Co.* v. *Sowa & Sons, Inc.*, 725 F.2d 1350, 1360, 220 U.S.P.Q. 763, 771 (Fed. Cir. 1984). No such deference is due with respect to evidence it did not consider. *Id.* Thus, while the court is to give "appropriate consideration and due weight" to the PTO's decision, its decision is not controlling nor is it binding on the court. *Interconnect Planning Corp.* v. *Feil*, 774 F.2d 1132, 1139, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985). On the basis of the evidence before the courts, the courts can and do decide differently from the PTO examiner. *Tyler Refrigeration* v. *Kysor Indus. Corp.*, 777 F.2d 687, 690, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985).

While the PTO examiner did consider the prior art which is before me, I note that the PTO did not have the actual Nike Astrograbber or the Nike Waffle Racer shoes. It considered only printed publications showing those shoes. In addition, the PTO stated that the photocopies of the publications showing the shoes were not clear (Reexamination No. 90/001266, p. 3 (Plaintiff's Exhibit 3)). Based on the unclear photocopies the PTO stated that it "appears" that the cited publications did not show Badalamenti's running shoe sole. Moreover, plaintiff did not brief nor did the PTO discuss the Bowerman patent in either the prosecution or the reexamination.

With due deference to the PTO and keeping in mind plaintiff's presumption of validity, here, where there are no disputed facts, I can decide the issue of validity of plaintiff's patent in a motion for directed verdict.

*III.*

OBVIOUSNESS

The U.S. Constitution authorizes Congress "To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." Art. 1, § 8, cl. 8. This clause is "both a grant of power and a limitation." *Graham*, 383 U.S. at 5. Patent law sets out the limitations in three conditions for patentability: novelty, utility, and non-obviousness. 35 U.S.C. §§ 101-103. Section 103 on non-obviousness reads in relevant part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such

> that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . .

As the legislative history makes clear, although an invention may be "new", it may still be obvious if the difference between the prior art and the invention is not great enough to warrant the monopoly granted by patent law. S. Rep. No. 1979, 82d Cong., 2d Sess. (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. (1952) *quoted in Graham*, 383 U.S. at 14-15; *cf. Union Carbide Corp.* v. *American Can Co.*, 724 F.2d 1567, 1575, 220 U.S.P.Q. 584, 591 (Fed. Cir. 1984).

The Supreme Court has enunciated the test for obviousness under section 103 in *Graham* v. *John Deere Co. of Kansas City:*

> While the ultimate question of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

383 U.S. 1, 17 (1966) (citation omitted).

## *IV.*

## THE REQUIRED ANALYSIS

After interpreting the claims of the patent at suit, obviousness is determined by performing the factual inquiries required by *Graham*, taking into consideration any expert testimony on the issue.

### A. *Claim Interpretation*

Preceding the factual inquiry required by *Graham* the court must interpret the claim: what is the invention claimed? *Panduit*, 810 F.2d at 1567-68, 1 U.S.P.Q.2d at 1597. The two claims at issue are claims 1 and 6. Claim 1 reads:

> A running shoe comprising an outer side, an inner side, a sole, a first traction surface, and a second traction surface, wherein: said first traction surface and said second traction surface are associated with and disposed on the inner side and the outer side, respectively, of the upper portion of said shoe: each of said traction surfaces extends along a side of said shoe from about the forward portion of the heel to about the region where the toe area commences; and each of said traction surfaces is disposed above said sole of the shoe at an acute angle; whereby, when said shoe is rotated about a horizontal axis, at least one of said traction surfaces is brought into contact with the ground surface.

Plaintiff's Patent, col. 4, ll. 12-14.

Claim 6 reads:

> The shoe of claim 1 wherein the traction surfaces comprise a plurality of nubs protruding from the traction surface.

*Id.* at ll. 37-39.

The language of plaintiff's claims at suit are straightforward. I find that plaintiff claims an angled traction surface composed of nubs. The traction surfaces are located above the bottom of the sole at an acute angle to it and are located along both sides of the shoe from the forward portion of the heel to the toe area. They provide traction when the shoe is rotated horizontally. In addition, plaintiff's and his expert witness's testimony have confirmed this meaning. (Badalamenti, Tr. 37-38 & 75-77; Ali, Tr. 273, 303, 312).

B. *The Graham Analysis*

In considering the obviousness issue, the U.S. Court of Appeals for the Federal Circuit requires the *Graham* analysis. *Graham* suggests factual inquiries in four areas: (1) ascertaining the scope and content of the prior art; (2) determining the differences between the prior art and the claims in issue; (3) determining the level of ordinary skill in the pertinent art; and (4) considering any secondary considerations or objective evidence. In light of the answers to these inquiries, the court must address the question of whether the differences would have been obvious to one reasonably skilled in the pertinent art at the time of plaintiff's invention. *Graham*, 383 U.S. at 17.

1. Scope and content of the prior art

An analysis of the record shows that the parties have not contested the scope or content of the prior art. The prior art is that cited in the prosecution and the reexamination, introduced by plaintiff. It is: (1) the Bowerman patent; (2) Nike Astrograbber shoe; (3) Nike Waffle Racer shoe; (4) the Cisko patent; (5) the Lyne patent; and (5) [*sic*, 6] the Lotus patent. My discussion of the prior art is as follows.

a. *Bowerman*

The Bowerman patent is for an "athletic shoe for artificial turf with molded cleats on the sides thereof." Bowerman Patent, pg. 1. The invention claimed is for an athletic shoe for artificial turf or other hard surfaces "which employs molded cleats of resilient material on the bottom of the shoe and on both sides thereof for greater traction." *Id.* at col. 2, ll. 5-8. The preferred embodiment for the side cleats is:

> [A] cover strip 20 of resilient material having a plurality of second cleats 22 molded integral therewith is attached to opposite sides of the shoe upper as well as around the toe portion and heel portion of such upper. These second cleats 22 may each have a polygon-shaped ground-engaging surface 24 and greatly improve traction when the athletic shoe is used for sports such as baseball, football or soccer requiring lateral movement and rapid changes in direction during which the shoe is partially twisted or rolled sideways so that such second cleats engage the artificial turf or other hard surface. Patent col. 3, ll. 15-26.

The function of the side cleats is to provide traction during lateral movement or changes in direction:

> The second cleats 22 on the side of the shoe upper provide no cushioning during normal straight ahead running, but are *primarily for providing additional traction during lateral movement or changes in running direction.*

*Id.* at ll. 46-50 (emphasis added).

The specific invention claimed by Bowerman is:

> An athletic shoe comprising: . . . a cover strip extending partially over the outer surface of said

> shoe upper around the toe portion and along the opposite sides of the shoe upper and having a plurality of second cleats molded integral with said cover strip on the opposite sides of said shoe upper.

*Id.* at col. 4, ll. 50-66.

b. *Nike Astrograbber and Waffle Racer*

The soles of the Nike Astrograbber and the Nike Waffle Racer ("the Nike shoes") are the same, only the uppers, which are not relevant to the patent in suit, differ (the Astrograbber is a football shoe for use on astroturf, the Waffle Racer is a crosscountry shoe).

The Nike shoes show an angled traction device on the side of the shoes which provides traction when the shoe is rotated. The Nike shoes have a wrapped sole. The sole wraps around the sides of the shoe in the front portion — the ball and toe areas — of the shoe. The sole, including the wrapped portion, has square projections or cleats. The cleats on the wrapped portion of the sole provide traction when the shoe is rotated as the person changes direction. Both plaintiff's expert witnesses, Ali and Montgomery, testified on cross-examination that the Astrograbber provides traction when the shoe is rotated laterally (Ali, Tr. 295-96 & 306; Montgomery, Tr. 297). Ali also testified that it provides traction throughout a thirty to forty-five degree angle (Tr. 297).

c. *Cisko patent*

The Cisko patent is for a baseball shoe with spikes to prevent slipping during base running. Cisko shows spikes located on the left side of both left and right shoes, located above the bottom of the sole so that they do not engage the ground unless the shoe is rotated. The spikes engage the ground upon rotation of the shoe

during base running, and prevent lateral slipping. The drawing shows that the spikes are at an acute angle relative to the sole or ground. Patent, figs. 4 & 5.

d. *Lyne patent*

The Lyne patent is for an attachment for a golf shoe, to provide traction and balance during the player's stroke. Lyne shows a traction device, or "pivot face", extending beyond the normal inner edge of the sole. The traction device is a continuation of the sole curving upward and outward from it. The traction device is provided with studs which prevent sideways slipping. Patent, p. 2, col. 2, ll. 52-56. As the player pivots during his swing the shoe rotates and the studs on the traction device engage the ground, providing traction. The drawing shows that the studs are at an acute angle relative to the sole or ground. Patent, figs. 5 & 6.

e. *Lotus patent*

The Lotus patent is for "shoes for sports wear", more particularly for playing golf. The Lotus patent shows a beveled or angled side sole at approximately forty-five degrees relative to the sole bottom. Studs are attached perpendicularly to the angled surface so that they also project at approximately forty-five degrees. Lotus patent, ll. 68-77. The side studs are located on both sides of the shoe, either on the ball of the foot or around the whole shoe. The purpose of the side studs is to prevent the shoes from slipping when they are turned on their edges.

The prior art discussed above is undisputed. The parties do dispute the interpretation of the prior art's claims. This is a matter for the court, to which I now turn.

2. Differences between the prior art and invention in suit

The second inquiry required by *Graham* is a determination of the differences between the prior art and the claims of the patent at suit. I find that the differences between plaintiff's claims and the prior art are negligible at best, and as a matter of law do not attain the difference which is afforded protection under patent law.

In comparing plaintiff's invention and what the prior art teaches, it is important to make clear what plaintiff does *not* claim in his patent. Plaintiff does not claim one acute angle over another for the side traction surface. Neither does he claim a certain transition between the sole and the side traction surface, such as curved versus angled. Nor does he claim a certain disposition (straight versus curved) of the surface to which the nubs are attached (the drawings show a straight surface). He does not claim any specific size, shape, or disposition of the cleats on the side traction surface (Tr. 125-26).

Plaintiff simply claims an acutely angled traction surface composed of cleats or nubs along the sides of the shoe from forward of the heel to the toe area. This claim must be compared to the prior art in determining the differences between them.

The single most relevant prior art is the Bowerman patent. The differences between the Bowerman patent and the plaintiff's invention are minimal or nonexistent. The Bowerman patent shows an angled traction device composed of nubs along the sides of the shoe. The purpose of Bowerman's patent is to provide greater traction for quick turning laterally. The purpose of plaintiff's patent is to provide lateral traction. Bowerman accomplishes this by cleats along the sides of the shoe. Plaintiff's patent accomplishes this by nubs or cleats along the side of the shoe. The Bowerman

patent achieves its purpose as the side cleats engage the surface when the shoe is twisted or rolled sideways. Plaintiff's patent achieves its purpose as the traction surface along the sides of the shoe is brought into contact with the ground when the shoe is rotated. In short, Bowerman shows plaintiff's claimed invention — nubs or cleats on an acutely angled traction surface along both sides of the shoe to provide traction when the shoe is rotated.

The only difference plaintiff could cite between Bowerman and his patent was the acute angle of the side traction surface (Tr. 500). Plaintiff relies solely upon the drawing of the Bowerman patent as his support for the contention that Bowerman, and consequently the prior art, does not teach a traction device at an acute angle (Ali, Tr. 325; Brooks, Tr. 500). This reliance is misplaced. A fair reading of the claims and specifications of Bowerman shows that it teaches an angled traction surface, and that the drawing showing a traction surface at a right angle to the sole or ground surface is in error. Furthermore, the other prior art teaches an angled traction surface located above the sole.

Obviousness is to be determined not only by what the prior art expressly teaches, but by what it would suggest. "The question of obviousness depends, furthermore, on 'not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art.'" *Leinoff* v. *Louis Milona & Sons, Inc.*, 726 F.2d 734, 739, 220 U.S.P.Q. 845, 848-49 (Fed. Cir. 1984), *quoting In re Simon*, 461 F.2d 1387, 1390, 174 U.S.P.Q. 114, 116 (C.C.P.A. 1972).

I find that the angled traction surface is, if not a necessary implication of Bowerman, at the very least clearly suggested by it. The specifications state that in

the preferred embodiment for the side cleats the side cleats engage the surface and provide traction upon partial lateral rolling or twisting:

> [The side cleats] greatly improve traction when the athletic shoe is used for sports . . . requiring lateral movement and rapid changes in direction during which the shoe is *partially twisted or rolled sideways* so that such second cleats engage the . . . surface.

Bowerman patent col. 3, ll. 21-26 (emphasis added).

A patentee cannot escape the teaching of a prior art patent based upon an interpretation of the drawing if the specifications are otherwise clear. *Cf. Ziegler* v. *Phillips Petroleum Co.*, 483 F.2d 858, 869, 177 U.S.P.Q. 481, 488 (5th Cir. 1973), *cert. denied*, 414 U.S. 1079, *quoting Edward Valves, Inc.* v. *Cameron Iron Works, Inc.*, 286 F.2d 933, 942 (5th Cir. 1961), *cert. denied*, 368 U.S. 833 ("It is well settled that the claims delineate the scope of protection afforded by a patent, not the specific embodiments shown in patent drawings.") This is so especially where, as here, the drawing appears to be in error.

I find that in Bowerman the cleats can engage the surface upon partial lateral movement only if they are at an acute angle to the ground, and not at a nearly right angle as shown in the drawing. Plaintiff's expert witness Ali testified that the side cleats at a right angle as shown in the drawing would only engage the ground when the shoe was turned completely on its side (Tr. 254). As depicted in the drawing, the side cleats would not be functional.

Even if Bowerman did not teach an acutely angled traction surface, other prior art — the Nike shoes and the Lotus, Lyne, and Cisko patents — teaches an angled

traction surface. The Nike shoes show the wrapped portion of the sole disposed at an acute angle to the sole and the ground. The Lotus patent shows an angled side sole at a forty-five degree angle to the ground. The Cisko patent shows spikes located at an acute angle. The Lyne patent as well shows a traction device at an acute angle.

The prior art also shows the angled traction device on both sides of the shoe. The Nike shoes show a wrapped sole on both sides of the shoe on the ball and toe area, and Bowerman shows cleats on both sides all around the shoe. In addition, the Cisko patent, with cleats located on the left sides of the shoes for base running, would suggest to anyone of ordinary skill that if you wanted traction when running to the right, you would merely put spikes on the opposite side of the shoe.

In summary, a comparison of the prior art with plaintiff's invention shows that the difference between them is slight.

3. Level of ordinary skill in the art

Regarding the third inquiry required by *Graham*, the parties have not disputed the level of ordinary skill in this case. Defendant has agreed that plaintiff's expert witnesses establish an appropriate level of skill. *See Custom Accessories, Inc.* v. *Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962-63, 1 U.S.P.Q.2d 1196, 1201 (Fed. Cir. 1986); *Stratoflex*, 713 F.2d at 1538, 218 U.S.P.Q. at 878-79.

Plaintiff's expert Ali has some college education and has worked nineteen years in the sporting goods industry, for a number of years supervising the development and production of athletic shoes (Tr. 265-66). Plaintiff's expert Montgomery has a bachelor of science degree in

mechanical engineering and has worked in the athletic shoe trade for nine years (Tr. 380-81).

I find that a person possessing an applicable level of ordinary skill in the art is one with some college education and who has worked in the athletic shoe trade.

4. Secondary considerations

The fourth inquiry required by *Graham* is a consideration of objective evidence or secondary considerations. Secondary considerations are useful to guard against slipping into hindsight, *Graham*, 383 U.S. at 36; and must be considered when present, *Pentec, Inc.* v. *Graphic Controls Corp.*, 776 F.2d 309, 315, 227 U.S.P.Q. 766, 770 (Fed. Cir. 1985), and *Stratoflex*, 713 F.2d at 1538-39, 218 U.S.P.Q. at 879. There must be a nexus established between the merits of the claimed invention and the evidence of secondary considerations if the evidence is to be given substantial weight indicating nonobviousness. *Ashland Oil, Inc.* v. *Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 U.S.P.Q. 657, 673 n.42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017; *Simmons Fastener*, 739 F.2d at 1575, 222 U.S.P.Q. at 746; *Stratoflex*, 713 F.2d at 1539, 218 U.S.P.Q. at 879.

In the present case the parties presented evidence on commercial success and commercial acquiescence. Neither indicates nonobviousness. Badalamenti's shoe has not been commercially successful. He has not marketed the shoe itself, only confronted alleged infringers. Nor does the evidence of commercial acquiescence indicate nonobviousness. In the six years plaintiff has promoted his invention he has obtained only three licenses despite contacting "many" manufacturers (Tr. 503 & 91). The few licenses plaintiff has obtained do not

indicate nonobviousness.[1] Additionally, plaintiff has not shown a nexus between the merits of his invention and the licenses of record. *Stratoflex*, 713 F.2d at 1539, 218 U.S.P.Q. at 879.

Thus I find that the evidence of secondary considerations does not indicate nonobviousness.

### C. *Expert Testimony*

The court may consider an expert witness's testimony but it is not bound by the opinion of expert witnesses on the issue of obviousness. *Petersen Mfg. Co.* v. *Central Purchasing, Inc.*, 740 F.2d 1541, 1547-48, 222 U.S.P.Q. 562, 566-67 (Fed. Cir. 1984); *Pederson* v. *Stewart-Warner Corp.*, 536 F.2d 1179, 1180-81, 192 U.S.P.Q. 20, 22 (9th Cir. 1976), *cert. denied*, 429 U.S. 985.

Only Ali testified as to obviousness. His opinion was that plaintiff's shoe was not obvious in the light of the prior art. However, Ali stated that he had "briefly glanced" at the prior art references, some seventy patents (Plaintiff's Ex. 30), given to him by plaintiff (Tr. 274, 314-15).

I find that Ali's testimony does not indicate that plaintiff's invention is nonobvious.

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[1] As stated by Judge Frank in *Kleinman* v. *Kobler*, 230 F.2d 913, 914 (2d Cir. 1956), *cert. denied*, 352 U.S. 830:

> [W]e see no significance in the fact, found by the trial judge, that "four manufacturers, including Schick and Remington-Rand, Inc., two of the largest manufacturers, have procured licenses from the plaintiff." These are matters about which judges must not be too naive: To take a license, calling for small royalty payments, frequently involves less expense than prolonged litigation; besides, if the licenses are few, the licensees may deem it desirable to share a monopoly which will endure while the patentowner frightens off other users.

## V.

## CONCLUSION

I conclude that as a matter of law plaintiff's invention would have been obvious to one reasonably skilled in the pertinent art at the time of its invention.

A useful starting point for determining the issue of obviousness is Judge Rich's image in *In re Winslow. Union Carbide*, 724 F.2d at 1576, 220 U.S.P.Q. at 591. In *In re Winslow*, Judge Rich stated:

> We think the proper way to apply the 103 obviousness test to a case like this is to first picture the inventor as working in his shop with the prior art references — which he is presumed to know — hanging on the walls around him.

365 F.2d 1017, 1020, 53 C.C.P.A. 1574, 1578 (1966).

Imagining myself in a workshop with the prior art hanging on the walls around me, a comparison of plaintiff's patent with the prior art leads me to the conclusion that the minds of reasonable men could not differ that plaintiff's patent is obvious.

Plaintiff claims an angled traction surface composed of nubs disposed at an acute angle above the bottom of the sole along both sides of the shoe from the forward portion of the heel to the toe area. It provides traction when the shoe is rotated horizontally. Plaintiff's invention is obvious in light of the Bowerman patent showing an athletic shoe with side cleats disposed at an angle above the sole in order to provide traction when turning. Other prior art also shows an angled traction surface above the sole of the shoe — the Nike shoes and the Lotus, Cisko, and Lyne patents. The prior art further shows the side traction surface disposed from the forward portion of the heel to the toe area.

Such a disposition would have been obvious in light of the Nike shoes and the Bowerman and Cisko patents.

The differences between the prior art and plaintiff's patent do not amount to the degree necessary to be afforded protection under the patent laws. The differences are minimal at best. Considering all the evidence, in a light most favorable to plaintiff, drawing all reasonable conclusions in plaintiff's favor, keeping in mind the presumption of nonobviousness and giving deference to the Patent and Trademark Office's decision I find that defendant has presented clear and convincing evidence that plaintiff's patent is obvious. I find that the minds of reasonable men could not differ regarding the obviousness of plaintiff's patent. The differences between plaintiff's invention and the prior art would have been obvious to one reasonably skilled in the art at the time.

Accordingly, it is ORDERED that defendant's motion for a directed verdict be GRANTED.

IT IS SO ORDERED.

/s/ John Feikens
United States District Judge

Dated: February 18, 1988

*(Certification Omitted)*

## APPENDIX C

### JUDGMENT

(United States Court of Appeals — Federal Circuit)

(Dated October 28, 1988)

(MICHAEL J. BADALAMENTI, Plaintiff-Appellant, v. DUNHAM's, INC., KINNEY SHOE CORP. and HYDE ATHLETIC INDUSTRIES, INC., Defendants-Appellees — No. 88-1356)

*ON APPEAL from the* United States District Court for the Eastern District of Michigan

*in CASE NO(S).* 85-CV-71040-DT

*This CAUSE having been heard and considered, it is*

*ORDERED and ADJUDGED:*

AFFIRMED-IN-PART AND DISMISSED-IN-PART.

*ENTERED BY ORDER OF THE COURT*

/s/ *Francis X. Gindhart,*
*Clerk*

*DATED:* October 28, 1988

ISSUED AS A MANDATE: December 16, 1988
COSTS: Against, Appellant
PRINTING ---------- $423.64
TOTAL ---------- $423.64

## APPENDIX D

### ORDER

*– NOTE –*

*This order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest.*

*It is a public record. It is not citable as precedent.*

(United States Court of Appeals — Federal Circuit)

(Filed December 9, 1988)

(MICHAEL J. BADALAMENTI, Plaintiff-Appellant, v. DUNHAM's, INC., KINNEY SHOE CORP. and HYDE ATHLETIC INDS., INC., Defendants-Appellees — No. 88-1356)

Before: BISSELL and ARCHER, *Circuit Judges,* and BENNETT, *Senior Judge.*

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

FOR THE COURT

/s/ Francis X. Gindhart
Clerk

December 9, 1988

cc: Ernie L. Brooks
John L. Welch

# APPENDIX E

## EXCERPTS FROM TRIAL TRANSCRIPT

(United States District Court —
Eastern District of Michigan — Southern Division)

(MICHAEL J. BADALAMENTI, Plaintiff, v. DUNHAM's, INC., KINNEY SHOE CORPORATION, and HYDE ATHLETIC INDUSTRIES, INC., Defendants — Civil Action No. 85-71040; Hon. John Feikens)

* * *

ALTAF ALI — *Cross-Examination*

* * *

(293) * * * Q. (By Mr. Wolf): Now, you referred to the Bowerman patent, and I believe it was 4,194,310. Have you studied that particular patent?

A. No. I have seen it.

Q. Have you read it?

A. Yes.

Q. Would you look at Fig. 5 of that patent?

A. Yes.

Q. Does that show shoes with cleats (22)?

A. Yes, I see it.

Q. Are those cleats the cleats that would appear at the foxing on the side of the shoe?

A. I don't believe so.

Q. Let me go back and look at Fig. 1.

A. Yes.

(294) Q. I think you said there were cleats that went all the way around that engaged that appeared in the foxing?

A. Yes.

Q. Do you know what the purpose of those cleats were?

THE COURT: We're in Fig. 1 or Fig. 5?

MR. WOLF: Fig. I.

THE COURT: Now, the 22 cleats, the cleats marked (22)?

MR. WOLF: Yes, all the way around.

Q. (By Mr. Wolf): Do you know what the purpose of those cleats are?

A. Well, I know — I don't really, because it's a — you know — this shoe, to my knowledge, I never saw it in the marketplace, so I never actually looked at the shoe. All I'm looking at is a drawing.

Now, I don't know if this shoe was ever produced, so that I never actually handled the shoe. As people involved in the business, we tried to get a shoe and get a feel for it, so this shoe, I don't know in fact if it ever existed, but looking at it, I don't know what great function it would perform unless the foot was in this particular position (indicating), which means you've got to be virtually lying down, or the foot has got to be absolutely horizontal angle.

Q. Mr. Ali, would you look at the Astrograbber shoe, (295) Exhibit 62?

A. Yes.

Q. I direct your attention to the cleats that are on the periphery of the shoe or perimeter, and the forepart in the ball of the foot area.

A. This (indicating)?

Q. Yes, the first and second row of cleats. If that shoe is being worn and the player is standing on the ground, would those cleats normally touch the ground just standing there?

A. No.

Q. Okay, what do you have to do to make those cleats touch the ground?

A. You'd have to bring them into contact with the ground.

Q. You'd have to rotate the shoe?

A. Yes. I think that's right, yes.

Q. Now, isn't it true that the function then of those cleats would be to allow that shoe to engage the ground on rotation of the shoe when the player was turning?

A. Well, it certainly — if you did rotate the foot, it would give it, it would bring those cleats into contact.

Q. Well, in point of fact, isn't it the function of those particular cleats?

A. Well, you know, they've got them right up in front as well, up at the toe.

(296) Q. Well, I'm just talking about the ones at the sides.

A. Yes, if that's what they designed them for, but that would happen, yes.

Q. And so in point of fact, they would achieve the results that Mr. Badalamenti has set forth in the end of Claim 1, where he says when the shoe is rotated by the horizontal axis at least one of the traction surfaces is brought into contact with the ground surface; isn't that true?

A. It would minimally, yes.

Q. And couldn't you properly characterize that Astrograbber as having traction surfaces along either side of the shoe?

A. But — well, it does not come high enough to be functional. The unit, the studs that you see at the periphery are, as you know, as you can see, they're cut, they are, they don't have any substance to them so that you would get very little traction if you cut against that at the body weight of a reasonably well built athlete. It would not give you — it would move away

because the highest cleat that has any substance has got to be here (indicating).

Q. Well, if you were going to rotate the Astrograbber shoe, at what angle then would you say the uppermost rows of cleats engage when you rotate it?

(297) A. I'd say up to this point (indicating).

Q. Well, put it down on the flat surface, so that the jury can see. If a person was wearing it, how far over —

A. (Indicating.)

Q. Would you characterize that as maybe 30 to 45 degrees? Is that a fair statement?

A. Well, yes.

THE COURT: What did you say?

THE WITNESS: That's close, yes, about 30 degrees, maybe a little less.

Q. (By Mr. Wolf): So, at least about 30 degrees you would say the Astrograbber would have a function of engaging when the foot is rotated?

A. Yes.

Q. So with a minor rotation of 30 degrees, those upper cleats do engage?

A. They engage, yes.

Q. And that would be on either side?

A. Just depends how they touch it. It doesn't seem that the outside ones do that as well; maybe a little less of a degree.

Q. Now, I think you said just a moment ago that that wasn't far enough over, is that correct? You wanted to see the cleats come higher up the sides?

A. Well, there are two problems. They're not high enough (298) and they're not substantial enough to do any kind of penetration of the surface, so you are not getting the traction that the Badalamenti shoe provides or that the patent provides where you can get your foot at an axis of 40 degrees and twist against the ground

and receive traction. That prevents the slippage. This you would not get with this shoe.

Q. Are you saying the Badalamenti patent allows you to turn, say, 45 degrees, whereas the Astrograbber does not?

A. No, even at the 30 degrees you're not getting the penetration of the surface with these nubs or cleats, whatever you want to call them, as you do with the other device.

Q. For two reasons, you said, because the cleats are not long enough —

A. And they're not shaped correctly, if you like.

Q. Well, that's a third reason. Secondly, they're not shaped correctly, and third they don't go high enough up the sides, is that your testimony?

A. Right.

Q. You've never seen a shoe made like this, so you're testifying from these drawings, is that correct?

A. No. Right.

* * *

(317) * * * THE COURT: All right. Now, to the degree that you are able to answer this question, and if you are not able to answer it, I want you to tell me that you are not. I want to direct your attention to the test of obviousness.

You are sufficiently acquainted, I take it because of your work with concepts in patent law, of obviousness, are you not?

THE WITNESS: No, sir.

THE COURT: All right. Then let me tell you what one judge at least has said in defining what obviousness is, and I am referring to Judge Rich, who is on the United States Court of Appeals for the Federal Circuit, who said in the case, we think the proper way to apply the 103 obviousness test to a case like this is to

first picture the inventor as working in his shop with prior art references which he is presumed to know hanging on the walls around him. You have got that picture?

THE WITNESS: Uh-huh.

THE COURT: Now, I am trying to put you into that room and hanging around the wall would be this Astrograbber and those figures in the Bowerman patent.

(318) If that were the situation in which you now are placed as the person who is aware of this shoe and these figures, would that — and I assume for this purpose that you would be a person of ordinary skill in the art — would those references make what Mr. Badalamenti invented obvious to you, looking at the Astrograbber and those figures?

THE WITNESS: I don't understand what you mean, sir, when you say made it obvious.

THE COURT: This prior art?

THE WITNESS: Yes.

THE COURT: You are looking at prior art. I am asking you as a person of ordinary skill in the art, would those particular references make it obvious to you as to what Mr. Badalamenti said was unique?

THE WITNESS: Yes, I don't think these addressed what Mr. Badalamenti was interested in.

THE COURT: I know that, that is why I am asking you, if you were a person of ordinary skill in the art —

THE WITNESS: Yes.

THE COURT: With those references, if you had them —

THE WITNESS: Yes.

THE COURT: — before he conceived of this invention, if you are looking at it, would it be obvious (319) to you what he did was in that prior art?

THE WITNESS: I don't think — no, it would not be. I think that —

THE COURT: Why not?

THE WITNESS: Because I don't think that this addresses the problem that he was trying to address to the degree that he was doing it.

THE COURT: I am not trying to — I am not talking about the problem he was trying to address. I am trying to ask you whether or not this would suggest there was nothing unique about what he was trying to do, would it do that?

THE WITNESS: I don't think so, sir.

THE COURT: Why not?

THE WITNESS: Because I think that — if I had conceived it, I would go ahead and build that shoe and in that way, because these did not include it.

THE COURT: Do you think if you built that shoe it would be unique?

THE WITNESS: Yes.

THE COURT: Not suggested in any way by these, either this Astrograbber or those figures?

THE WITNESS: Well, I mean, it's an evolutionary thing. You know, obviously some of the things has come from this, meaning this addresses some part of the problem.

* * *

THOMAS MONTGOMERY — *Recross-Examination*

* * *

(392) Q. This one to some extent they do?

A. Minimal.

Q. You never tested the Astrograbber, have you?

A. Never have.

Q. So, you don't know the extent to which the Astrograbber would provide side traction from actual experience?

A. Based on my approximate nine years in the industry, with a great bit of that experience in cleated footwear, I would not judge that shoe that you have in your hands to be adequate for either an artificial surface or a natural grass surface because of the way it is designed.

MR. WOLF: I have no further questions.

THE COURT: Mr. Brooks?

MR. BROOKS: Nothing more, your Honor.

THE COURT: Do you have any questions, ladies and gentlemen?

Mr. Ketchum, would you get that question?

(A side bar discussion was had of the juror's question.)

THE COURT: The question that the jury asks is, I think that's Mr. Wilson: "Was there any Nike cleated footwear that addressed the problem of side traction in any direction?"

MR. WELCH: What time are you talking about?

THE COURT: If you want to, you can ask that (393) question.

(End of side bar conference.)

THE COURT: Okay. "Was there any Nike cleated footwear that addressed the problem of side traction?"

THE WITNESS: No, sir.

THE COURT: Any further questions?

(All said no.)

* * *

(414) "Q. Have you ever worn the MONSTER?

"A. Yes."

And, your Honor, and the jury, that was Plaintiff's Exhibit 10.

MR. WELCH: Can I just see that, your Honor?

MR. LAFONTAINE: Yes.

MR. WELCH: No objection.
THE COURT: All right.

(Plaintiff's Exhibit 10 received in evidence.)

MR. LAFONTAINE:

"Q. Have you ever worn the MONSTER?

"A. Yes.

"Q. Okay. And let me skip back to the ASTROGRABBER. When you wore the ASTROGRABBER, under what conditions did you wear it?

"A. You know, we had played six, seven games — as many as six, seven games a day and I would wear it to — when I first got them on I tried them out about wearing all the time, but the traction was not good enough for me playing the outfield or running the bases. So what I did, I wore those to give my feet a break from wearing the motel [*sic*, metal]: maybe wear them two out of seven games that day.

"Q. Okay. And you wore it over a span of (415) years?

"A. Over a couple of years.

"Q. Did you use the MONSTER in the outfield or in the infield and running the bases?

"A. I tested it both areas, outfield play and running the bases. However, we have a rep group who represents our products, also sells the MONSTER. So, I've been familiar with it for a couple of years.

"Q. In your experience, how did you find the traction of the ASTROGRABBER?

"A. I — well, this picture here, the cleats on making sharp cuts where you were running the bases I even had my feet — my feet would go right out from under me if I was going hard, you know, I was circling first base like you were going to go second or you cut it real hard and

it's just — and the outfield, we played a three man outfield where I played center field and did a lot of — I had to do more running than a normal outfielder or running the gaps and cutting. And if the ground was a little bit wet it was like ice-skating. I mean, they were terrible.[ "]